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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,828	11/16/2001	Omid McDonald	9-15504-1US	7647
20988	7590	01/18/2007	EXAMINER	
OGILVY RENAULT LLP 1981 MCGILL COLLEGE AVENUE SUITE 1600 MONTREAL, QC H3A2Y3 CANADA			THAI, HANH B	
			ART UNIT	PAPER NUMBER
			2163	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/987,828	MCDONALD ET AL.	
	Examiner	Art Unit	
	Hanh B. Thai	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on amendment filed 10/18/06.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-22,24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 2-22,24 and 25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. The following is a Non-Final Office Action in response to the amendment filed October 18, 2006 and the RCE filed 11/14/2006. independent claims 6, 15 and 24 have been amended. Claims 1 and 23 have been cancelled. Claims 2-22 and 24-25 are pending in this application.

Response to Arguments

2. Applicant's arguments regarding "a respective CDC is calculated for each record of a plurality of records stored in the memory of a token" (response 10/18/06, pages 7-8) of claims 2-22 and 24-25 have been considered but not found persuasive.

Ahlgren clearly discloses calculating in the electronic token a change detection code (CDC) for each record in the memory (col.2, lines 57-64, Ahlgren) and comparing the calculated CDC with a stored CDC (col.2, lines 64-67, Ahlgren) in the manner similar to the claimed language.

3. Applicant argues that "Ahlgren does not teach or fairly suggest that the UID field is used to enable continuous synchronization" (response 10/18/06, page 8). Examiner respectfully points out that this limitation does not reflect on the claimed language.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2-22 and 24-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the claimed limitation "a respective change CDC for each simultaneously existing record in the memory" is not defined anywhere in the Specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-22 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahlgren et al. (US 6,968,209 B1) new cited in view of Dietrich et al. (US 6,879,989 B2).

Regarding claim 6, Ahlgren discloses a method applied by an electronic token for identifying changed records in a memory of the electronic token, the method comprising:

- calculating in the memory a change detection code (CDC) for each record in the memory and storing the respective CDCs in the memory of the electronic token (abstract; col.2, lines 59-62 and col. 4, lines 9-22, Ahlgren discloses calculating checksum stored in the SIM card reads on the claimed "calculating in the memory a change detection code");
- comparing in the memory the calculated CDC with the stored CDC associated with the record in order to determine if the record has changed since the stored CDC was calculated (abstract; summary; col. 4, lines 24-34 and lines 58-65, Ahlgren) and

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- if the calculated CDC is not equal to the stored CDC, and saving the calculated CDC of the record as the stored CDC of the record (abstract; summary and col. 4, lines 35-54, Ahlgren).

Ahlgren, however, does not disclose preparing a SMS message in the electronic token and sending the message to a registering element. Dietrich discloses short message service for a mobile radio network including generating a short message service and sending the message to the subscriber (see summary; col. 2, line 48 to col. 3, line 10, Dietrich). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide a short message service of Dietrich into the Ahlgren's system to derive the invention as claimed. The motivation of doing so would have been to provide efficient and reliable use of the short message in updating records of the mobile device (col.1, lines 60-63, Dietrich).

Regarding claim 2, Ahlgren/Cheng combination further discloses a step of calculating a cyclic redundancy check (col.4, lines 10-22, Ahlgren).

Regarding claim 3, Ahlgren/Cheng combination further discloses a step of determining if the at least one associated record is changed and yields information regarding the change, the information being input to the predefined algorithm (summary; col.3, lines 11-21; col. 4, lines 24-34 and lines 58-65, Ahlgren).

Regarding claim 4, Ahlgren/Cheng combination further discloses the step of issuing a message to an electronic token reader in which the electronic token is docked, the message containing at least one parameter regarding the change for use by a registering element to which

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the message is sent by a token-resident applet via the electronic token reader (col.3, lines 11-21; col. 4, lines 24-34 and lines 58-65, Ahlgren).

Regarding claim 5, Ahlgren/Cheng combination disclose a step of setting a response pending flag which is cleared if an acknowledgement of the message is received, wherein the flag is used to indicate that a message was not acknowledged (col.4, lines 46-53 and line 66 to col.5, line 6, Ahlgren).

Regarding claim 7, Ahlgren/Cheng combination disclose a step of using any flag set in association with the stored CDC, in conjunction with the values of the stored CDC and calculated CDC to determine if the record was changed since a last acknowledged message related to the record was sent (summary; col. 2, line 48 to col. 3, line 10, Dietrich).

Regarding claim 8, Ahlgren/Cheng combination disclose a step of sending the message to the registering element, which performs at least one of: synchronization of data across multiple data stores; update of a system with respect to the record; back-up of the record; and provision of a service feature in dependence on the change to the record (col.4, lines 46-53 and line 66 to col.5, line 6, Ahlgren).

Regarding claim 9, Ahlgren/Cheng combination discloses steps of issuing a short message service message to a service provider that has access to the registering element (summary; col. 2, line 48 to col. 3, line 10, Dietrich).

Regarding claim 10, Ahlgren/Cheng combination disclose steps of: receiving information relating to the change; formulating a notice of change (NOC) message; and inserting as many NOC messages as possible into the SMS message before sending the SMS message (col.3, lines 11-21; col. 4, lines 24-65, Ahlgren).

Regarding claim 11, Ahlgren/Cheng combination disclose that the electronic token is a subscriber identity module and the step of comparing further comprises a step of applying a comparison algorithm that executes on the subscriber identity module, the comparison algorithm being adapted to compare a CDC of each of a plurality of abbreviated dialing numbers in the file; and the step of issuing comprises a step of directing a SMS message to the registering element, which is adapted to perform at least one of the following: ensure conformity of the file with other versions of the file stored elsewhere; back-up the file; and, provide a service feature in dependence on the change (col.3, lines 11-21; col. 4, lines 24-34 and lines 58-65, Ahlgren).

Regarding claim 12, Ahlgren/Cheng combination disclose steps of formulating the message by inserting the at least one parameter into respective fields of the message, and forwarding the message to the registration element (summary; col. 2, line 48 to col. 3, line 10, Dietrich).

Regarding claim 13, Ahlgren/Cheng combination discloses steps of inserting a record identifier, and information that specifies the change (col.4, lines 46-53 and line 66 to col.5, line 6, Ahlgren).

Regarding claim 14, Ahlgren/Cheng combination discloses a step of inserting a value that indicates one of the following: the record was added; the record was deleted; and the record was modified (col.3, lines 11-21; col. 4, lines 24-65, Ahlgren).

Regarding claim 15, Ahlgren discloses an apparatus for providing a service to a subscriber having an electronic token, the apparatus comprising:

a change detection applet stored on the electronic token including a microprocessor and a memory, the electronic token storing a set of records and change detection codes (CDCs)

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respectively associated with the records respectively associated with the records, the CDCs identifying a version of the stored record (abstract; col.2, lines 59-62 and col. 4, lines 9-22, Ahlgren discloses log file of records and a checksum stored in the SIM card reads on the claimed "electronic token storing a set of records and change detection codes"), said applet being adapted to be executed by the microprocessor of the electronic taken and adapted to identify any record that has been changed since a change detection code (CDC) for the record was stored in the card (summary; col. 4, lines 24-34 and lines 58-65, Ahlgren) by calculating a current CDC for the record and comparing such current CDC with the stored CDC (summary; col. 4, lines 24-65, Ahlgren).

Ahlgren, however, does not disclose preparing a SMS message in the electronic token and sending the message to a registering element. Dietrich discloses short message service for a mobile radio network including generating a short message service and sending the message to the subscriber (see summary; col. 2, line 48 to col. 3, line 10, Dietrich). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide a short message service of Dietrich into the Ahlgren's system to derive the invention as claimed. The motivation of doing so would have been to provide efficient and reliable use of the short message in updating records of the mobile device (col.1, lines 60-63, Dietrich).

Regarding claim 16, Ahlgren/Cheng combination discloses the change detection applet calculates a cyclic redundancy check (CRC) to derive the current CDC (col.4, lines 10-22, Ahlgren).

Regarding claim 17, Ahlgren/Cheng combination discloses back up records for which the NOC message was generated; synchronize the file with other files remotely stored but commonly associated with a subscriber; and, provide a service dependent upon the detected change (col.4, lines 10-65, Ahlgren).

Regarding claim 18, Ahlgren/Cheng combination discloses the electronic token is docked in a communications enabled device that comprises an electronic token reader adapted to exchange data in conformity with a predetermined protocol (col.3, lines 11-21; col. 4, lines 24-34 and lines 58-65, Ahlgren).

Regarding claim 19, Ahlgren/Cheng combination discloses a subscriber identity module (SIM) card compliant with a global system for mobile communications (GSM) standard; and a universal SIM (USIM) card (see Fig.1-3 and corresponding text, Ahlgren).

Regarding claim 20, Ahlgren/Cheng combination discloses the communications enabled device is adapted to function as a short message service (SMS) enabled telephone (col.3, lines 11-21; col. 4, lines 24-34 and lines 58-65, Ahlgren).

Regarding claim 21, Ahlgren/Cheng combination discloses a data store for storing a set of response pending flags that are associated with a list of records in the file, and the change detection applet is further adapted to use the set of response pending flags to determine if a record may have been changed since a last NOC message for the record was acknowledged (col.4, lines 46-53 and line 66 to col.5, line 6, Ahlgren).

Regarding claim 22, Ahlgren/Cheng combination discloses the set of response pending flags comprises at least two flags used to encode change information, and the change detection applet is further adapted to use the plurality of flags, in conjunction with the stored CRC and

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current CRC, to determine if a notice of change message related to the record is to be sent (summary; col. 2, line 48 to col. 3, line 10, Dietrich).

Regarding claims 24-25, Ahlgren discloses a change applet stored on an electronic token including a microprocessor and a memory, the electronic token storing a set of records and change detection codes (CDCs) respectively associated with the record, the CDCs identifying a version of the stored record, said applet being adapted to be executed by the microprocessor of the electronic token and adapted to identify any record that has been changed since a change detection code (CDC) of the record was stored in the card (abstract; col.2, lines 59-62 and col. 4, lines 9-22, Ahlgren discloses log file of records and a checksum stored in the SIM card reads on the claimed "electronic token storing a set of records and change detection codes"), by calculating a current CDC for the record and comparing such current CDC with the stored CDC (col.2, lines 59-62 and col. 4, lines 9-65 Ahlgren discloses calculating checksum stored in the SIM card and comparing the checksum reads on the claimed "calculating a current CDC" and "comparing current CDC with the stored CDC").

Ahlgren, however, does not disclose preparing a SMS message in the electronic token and sending the message to a registering element. Dietrich discloses short message service for a mobile radio network including generating a short message service and sending the message to the subscriber (see summary; col. 2, line 48 to col. 3, line 10, Dietrich). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide a short message service of Dietrich into the Ahlgren's system to derive the invention as claimed. The motivation of doing so would have been to

provide efficient and reliable use of the short message in updating records of the mobile device (col.1, lines 60-63, Dietrich).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh B. Thai whose telephone number is 571-272-4029. The examiner can normally be reached on 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hanh B Thai
Examiner
Art Unit 2163



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January 10, 2007